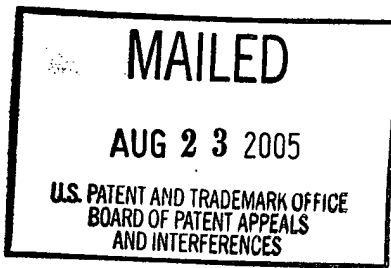


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS



AND INTERFERENCES

Ex parte SURESH K. MARISSETTY

Appeal No. 2005-1400
Application No. 10/081,659

ON BRIEF

Before THOMAS, HAIRSTON, and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 36-90, which constitute all the claims pending in the application.

The disclosed invention pertains to a method and apparatus for power management of multiple and/or configurable

devices within a computer system. More particularly, the invention is described as improving dedicated device driver software power management solutions as well as operating-system-transparent microcontroller-based solutions by utilizing a software solution with appropriate capabilities to accommodate devices with variable configurations.

Representative claim 36 is reproduced as follows:

36. A machine-readable medium having stored thereon instructions, which if executed by a machine, cause said machine to perform operations comprising:
determining an amount of time a processor is in a first power consumption state, said amount of time said processor is in said first power consumption state comprising a period of time in which a clock of said processor is stopped;
reducing a voltage level applied to said processor in response to said amount of time said processor is in said first power consumption state.

The rejection is based on the following patent:

Marisetty	5,590,342	Dec. 31, 1996
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Claims 36-90 stand rejected under 35 U.S.C. § 251 as being based upon a defective declaration under 37 CFR § 1.175(a)(1). Claims 36-90 also stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter which was surrendered in the application for the patent upon which this reissue application is based.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal and the rejections advanced by the examiner. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the declaration filed by appellant with the Notice of Appeal complies with 37 CFR § 1.175, which was the rule in effect at that time. We are also of the view that the present claims on appeal do not violate the reissue recapture rule. Accordingly, we reverse.

We consider first the rejection of all the appealed claims as being based on a defective reissue declaration. We note that several reissue declarations have been filed by appellant. The rejection in the examiner's answer refers to the declaration filed on December 29, 2003. This declaration improperly noted that the claims of the original patent were limited to a "device manager," when, in fact, the claims of the

patent were limited to a "virtual device driver." We believe that this improper reference to the claim language formed the basis for the examiner's rejection. Appellant filed a new declaration concurrent with the filing of the Notice of Appeal. This declaration correctly notes that the error in the claims relates to the claiming of a "virtual device driver." The rejection in the answer does not refer to this declaration, but the examiner does refer to this declaration in the response to arguments section of the answer. Specifically, the examiner states the following:

the reissue declaration filed along with the Notice of Appeal is in compliance with the Rules and the MPEP's requirements related to the identification of an error. However, the phrase "without deceptive intention on my part" is insufficient. The language should read "without deceptive intention on the part of the applicant" because this language encompasses not only the inventor but also his attorneys and assigns [answer, page 23].

Thus, we view the examiner's rejection based on the declaration as now being nothing more than an objection to the phrase "without deceptive intention on my part" which appears in the declaration filed with the Notice of Appeal.

We will not sustain this rejection of the claims on appeal. We see no material difference between the phrase

"without deceptive intention on my part" when stated by the applicant and the phrase "without deceptive intention on the part of the applicant" as required by the examiner. The term "my" in the declaration refers to the applicant who signed the declaration. Therefore, the phrase "my part" means the applicant's part or on the part of the applicant. Therefore, we interpret the phrase "my part" when stated by the applicant as equivalent to the phrase "the part of the applicant."

We now consider the rejection of all the appealed claims as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue application is based. The following facts are pertinent in considering the rejection before us. The application which became the Marisetty patent originally recited a "device driver" for controlling the power delivered to various devices. In response to a rejection by the examiner, appellant amended the claims to recite a "virtual device driver." The present claims on appeal do not recite a "virtual device driver," and the examiner finds this to be an attempt to recapture surrendered subject matter.

The examiner applied the three part test for determining whether or not recapture exists citing Pannu v. Storz Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); In re

Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); and Ex Parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003).

Under the first step of the test, the examiner finds that the elimination of the "virtual device driver" from the claims on appeal constitutes a broadening of the claims of the patent. Under the second step of the test, the examiner finds that this broadening aspect of the reissue claims on appeal is related to the surrendered subject matter. Under the third step of the test, the examiner finds that the narrowing limitations of the claims on appeal are not a material narrowing of the surrendered subject matter with respect to the prior art rejection [answer, pages 5-8].

Appellant argues, inter alia, that recapture does not exist when a material limitation has been added to the claims. Appellant notes that the claims on appeal are materially narrower than the claims of the patent because they recite specific functions that may be performed by a virtual device driver. Appellant argues that the examiner has taken the position that a limitation added to a claim can never be removed by reissue. Appellant does a side-by-side comparison of the independent claims on appeal and the claims of the patent to show that the independent claims on appeal differ materially from the claims of the patent [brief, pages 10-41].


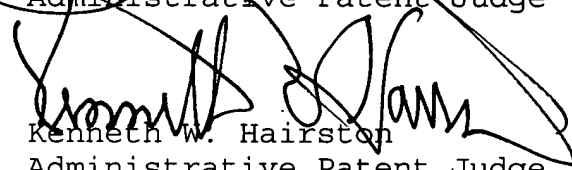
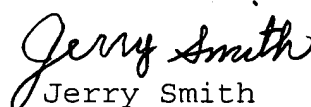
The examiner responds that although the functions added to the appealed claims can be performed by a virtual device driver, that does not mean that they are performed by a virtual device driver. Basically, the examiner takes the position that the claim limitations directed to determining a power consumption state by determining an amount of time that a clock is stopped are not related to the virtual device driver of the patent claims [answer, pages 8-21].

Appellant responds that the claims on appeal have been narrowed in a material way because they recite at least two functions which are performed by a virtual device driver whereas the patent claims recited any virtual device driver. Appellant notes that he has simply removed the name of a device in the claims on appeal and added limitations which relate to the functions performed by that device. Appellant asserts that the claims pass the third step of the three part test because the reissue limitations are related to the surrendered limitation, "virtual device driver," as the new limitations recite specific functions of a virtual device driver, and the added reissue limitations materially narrow the independent claims as they relate to only a subset of functions that can be performed by a virtual device driver [reply brief].

We will not sustain the examiner's rejection of the claims on appeal based on improper recapture for essentially the reasons argued by appellant in the briefs. Most importantly, we agree with appellant that the limitations added to the claims on appeal with respect to determining an amount of time that a processor is in a first power consumption state and reducing a voltage level in response to the amount of time are functions performed by the device driver or the virtual device driver of the patent claims. Thus, we agree with appellant that these added limitations constitute a material narrowing of the virtual device driver of the patent claims. Although the claims on appeal no longer require that these functions be performed by a virtual device driver, the functions themselves describe the operation of whatever device driver is present. Thus, the virtual device driver of the patent has been broadened in that the device driver no longer has to be "virtual," but it has been materially narrowed in that whatever device driver is present, it must perform the specific functions recited in the claims on appeal. Since the examiner is of the view that the added limitations are not a material limiting of the claims with respect to the prior art, we suggest that the examiner simply establish a record as to why the claims on appeal are not patentable over the prior art under 35 U.S.C. §§ 102 or 103.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 36-90 is reversed.

REVERSED

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James D. Thomas)	
Administrative Patent Judge)	
)	
Kenneth W. Hairston)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
Jerry Smith)	
Administrative Patent Judge)	

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